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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/851,257 | 05/08/2001 | Shawn Thayer Huxel | ETH-1554 | 2990 |

27777 7590 03/29/2004

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EXAMINER

STEWART, ALVIN J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3738

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,257

Applicant(s)

HUXEL ET AL.

Examiner

Alvin J Stewart

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/08/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/12/04 has been entered.

Claim Objections

The numbering of the claims are not in order. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented.

Misnumbered claims 49-55 been renumbered as 44-50. ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 28-43 and 49-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,494,908 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the Application discloses all the structure limitations claimed in claims 1-26. However,

Art Unit: 3738

US Patent 6,494,908 B1 does not disclose an independent claim having the combination of a polymer selected from the group consisting of polyacrylamides, ... and monomers.

It has been held that a claim is anticipated if each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or practice.

Kalman vs. Kimberly-Clark Corp., 218 USPQ 789.

Finally, the combination of the above two different polymers is well known in the art and it would have been obvious to one ordinary skill in the art to combine the above two different polymers.

Claims 28-43 and 49-55 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 10/196,845. Although the conflicting claims are not identical, they are not patentably distinct from each other because the Application discloses all the structure limitations claimed in claims 1-27 of copending application. However, US Application 10/196,845 does not disclose an independent claim having the combination of a polymer selected from the group consisting of polyacrylamides, ... and monomers.

It has been held that a claim is anticipated if each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or practice.

Kalman vs. Kimberly-Clark Corp., 218 USPQ 789.

Finally, the combination of the above two different polymers is well known in the art and it would have been obvious to one ordinary skill in the art to combine the above two different polymers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 5 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 39-43, 50, 51 and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Bregen et al US Patent 5,728,135.

Bregen et al discloses a biodegradable filament comprising an elongated flexible member (1) having a polymeric coating having sufficient mechanical integrity (see col. 2, lines 19-22) and a plurality of polymer compositions (see col. 2, lines 25-34).

Regarding claims 40-42, see col. 2, lines 19-31.

Regarding claim 43, see Figure 1.

Regarding claims 50 and 51, see col. 1, lines 66-67.

Regarding claim 54, see col. 2, line 11.

Claim 39 is rejected under 35 U.S.C. 102(b) as being anticipated by Suhonen et al US Patent 5,357,990.

Suhonen et al discloses a filament (2) (see col. 3, lines 24-34) comprising a plurality of flexible members (4) coated with a bioabsorbable (see col. 3, lines 35-45) polymer (6 & 10) wherein the polymeric coating has sufficient mechanical integrity to effectively maintain the flexible member in a substantial fixed configuration (see col. 4, lines 61-68).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 49, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bregen et al US Patent 5,728,135.

Bregen et al disclose the invention substantially as claimed. However, Bregen et al does not disclose a suture made of multifilament and a coating that has a transition temperature above 55°C.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the Bregen et al reference with the multifilament and coating having a transition temp. above 55°C because Applicant has not disclosed that the above limitations provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the monofilament and the polymeric properties of the Bregen et al reference because the monofilament and material property of the

Art Unit: 3738

coating of the above reference will maintains a sufficient mechanical integrity to sufficiently allow the quick insertion of the stiffened suture and eyelet.

Therefore, it would have been an obvious matter of design choice to modify the Bregen et al reference to obtain the invention as specified in claims 49, 52 and 53.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J Stewart whose telephone number is 703-305-0277. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. Stewart
Alvin Stewart
March 24, 2004.